



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,875	02/15/2001	Subbu Srinivasan	CSCO-110932.US.P	4569

7590 03/31/2004

WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER

MITCHELL, KATHERINE W

ART UNIT	PAPER NUMBER
----------	--------------

3677

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,875

Applicant(s)

SRINIVASAN

Examiner

Katherine W Mitchell

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Drawings

The drawings are objected to because numerous reference numbers, labels, and lead lines are unclear and hard to read. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Examiner notes the amendment adding "computer-implemented" in the preamble. Examiner is considering that every step of the processing method is implemented by computer, thus inherently including a computer in said steps. Therefore, the 101 rejection is canceled.
3. Applicant is reminded of the proper format for amendments – specifically, deleted parts should have a strike-through. It appears applicant has used "[[]]" to indicate deleted material. This will be unacceptable in the future.

Rule 105 Request

4. The scope of 37 CFR 1.105 is extended to any assignee because the information required may be known to some members of the assignee even if not known by the inventors.

The authority for the Office to make such requirements arises from the statutory requirements of examination pursuant to 35 U.S.C. 131 and 132. An examiner or other

Art Unit: 3677

Office employee may make a requirement for information reasonably necessary to the examination or treatment of a matter in accordance with the policies and practices set forth by the Director(s) of the Technology Center or other administrative unit to which that examiner or other Office employee reports.

Examiner is requesting any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or services the claimed subject matter has been embodied in. Specifically, "Inside the Cisco Web Site" from Nov/Dec 1997 *Internet Computing Online* (hereafter called *Cisco*) indicates that Cisco's web site had validation and revalidation functions, and referenced (pg 5 of 8) engineers configuring an order and sending the order on to purchasing for approval, and page 2 indicates that saved configurations are reloaded into the configurator and revalidated because "things change so quickly, and we may obsolete a certain software that you have today, so that you still need to revalidate each order." This does not specifically address the delay between order and approval, but indicates this was a known concern of Cisco, the assignee. Similarly, the Cisco article teaches user registration, and would imply a password and user identification, and examiner requests information on that function also. Therefore, examiner requests any documentation assignee has concerning:

- revalidation after delays in order approval;

- user authentication with passwords, and

- acceptance of incomplete orders

were first available on its website.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3, 5, 21, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 was amended and appears to delete (e) and (f). Claim 5 was amended to delete "d". Examiner will assume the newly added descriptions are additional steps.

Claim 25 recites the limitation "optional order processing information" in line 3. There is insufficient antecedent basis for this limitation in the claim. Examiner has no way of determining what information is optional, and is examining as if any or all order processing information is optional.

Claim 21 is rejected as unclear, as examiner cannot tell if step a1) in claim 21 is in addition to step a1) in claim 20, or if it replaces the step. Examiner notes that a dependent claim cannot contradict the claim from which it depends, and it appears claim 21 as best understood by examiner contradicts claim 20.

Sometimes applicant has dependent claims "further comprising" a step already recited (for example claim 3), and sometimes applicant claims "comprising" a step already recited (for example, claim 21). Examiner assumes "further comprising" adds to all the steps of the claim from which the dependant claim depends, and assumes "comprising" means the common step is replaced unless the step includes a modified sub-number; i.e., "e" comprises "e1" is taken to mean "e" further comprises an additional

Art Unit: 3677

step. In no circumstances, however, is a dependent claim allowed to be broader than or contradictory of the independent claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 6-15, 17, 22, 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by “Inside the Cisco Web Site”, hereafter called Cisco.

Re claims 1-2: Cisco teaches a computer-implemented method and means for processing an electronically placed order for customer-configured products (page 2, 2nd –4th Q/A pairs,) comprising

- A. Receiving a customer-configured product configuration (pg 5, last Q/A pair)
- B. Determining if product configuration is valid (pg 2, 3rd Q/A pair)
- C. If valid, continuing processing order (pg 2, last 4 Q/A pairs)
- D. Receiving order approval (pg 5, last Q/A pair)
- E. If less than a predetermined time period passes between order and approval, continue processing said order (page 4, 2nd Q/A pair), without determining if the configuration in “C” is still valid.

Re claims 6-8: Fields for required order processing information are taught in pg 2, 3rd Q/A pair –how much RAM, what peripherals, etc and in page 5, last Q/A pair – bill-to,

Art Unit: 3677

ship-to, PO number, etc). Determining whether all required order processing has been provided is inherently taught, as pg 2, 3rd –4th Q/A pairs teach that if certain fields are selected, other features are correlated to result in a valid order, and page 5 teaches checklist for order entry.

Re claim 9: receiving the order via the internet is taught in page 1, 2nd Q/A pair and throughout.

Re claims 10-12,15: Cisco teaches a computer-implemented method and means for processing an electronically placed order for customer-configured products (page 2, 2nd –4th Q/A pairs,) comprising

- A. Receiving a user who is electronically transferred from application or web-site operable to access e-procurement application to a web site operable to access an ordering application (IPC, page 2 –3)
- B. Allowing customer-configured product configuration (pg 5, last Q/A pair)
- C. Continue processing without determining if order information is valid and complete (pg 5, last Q/A pair)
- D. Transferring e-copy of order to e-procurement application (page 3-4)
- E. Receiving order approval (pg 5, last Q/A pair) from user transferred from e-procurement web site to ordering application web site.
- F. After approval, determine if valid and complete order (pg 5, pg 2)

Art Unit: 3677

- G. If less than a predetermined time period passes between order and approval, continue processing said order (page 4, 2nd Q/A pair) without further determining if the product configuration is valid. (for example, predetermined period is negligible, as item is reorder, page 5)

Re claims 13-14: It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). The computer running the application would be selected based on customer's requirements and equipment.

Re claim 17: Determining if product configuration is valid in step "B"(pg 2, 3rd Q/A pair)

Re claim 22: Service contracts as part of an order are taught in the last line of page 2- first 4 lines of page 3, and Cisco states that service orders are treated just as a finished goods order, thus inherently they are part of the configuration process, orders must be validly configured with service contracts appropriate for the hardware and software selected.

Re claim 26: Means for automatically processing an electronically placed order, comprising:

- A. Means for electronic order creation, with a customer-configured product configuration (pg 5, last Q/A pair) and fields for required order processing information are taught in pg 2, 3rd Q/A pair –how much RAM, what peripherals, etc and in page 5, last Q/A pair – bill-to, ship-to, PO number, etc).

Art Unit: 3677

- B. Means for determining if product configuration is valid (pg 2, 3rd Q/A pair)
- C. Means for receiving order approval (pg 5, last Q/A pair)
- D. Means for determining if required order processing information is valid and complete (page 5)
- E. Means for determining if more than a predetermined time period passed between order and approval. (page 2, saved configuration)

Re claim 27: Authorization determination is taught in page 5.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5, 16, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cisco in view of Mitra et al. US20010014878.

Re claims 3-5, 16: Cisco teaches on page 5 of 8, paragraphs 7-8 of 10 that an engineer starts an order, specifying the configuration, and then the order goes to Purchasing for administrative matters and approval. Page 7 of 8 discloses that quote/order/ configuration and price/invoice loop of ordering are known, and page 2 4th Q/A pair teaches that revalidation is critical after time has passed, because change is fast and software becomes obsolete quickly in the computer field. Whether the time

Art Unit: 3677

delay is between ordering and approval, or ordering and reordering, the time delay is known to be a reason for revalidation, and revalidation is taught as a capability after certain time delays. Defining the time interval, based on intervals observed, and allowing interval flexibility would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

However, Cisco is not explicit that revalidation after approval is performed. Mitra teaches in col 2 para [0029] that upon receiving a purchase request, the seller verifies (validates) the purchase information (items/services are still being offered, prices). Para [0030] and [0041] teaches an additional verification/validation step after approval of the purchase request (items still available, price still correct).

It would have been obvious to one of ordinary skill in the art, having the teachings of Cisco and Mitra before him at the time the invention was made, to modify Cisco to include revalidation after all significant time delays, including between order placement and approval, as taught by Mitra, in order to ensure that orders are still validly configured. One would have been motivated to make such a combination because changes and software obsolescence are common in the computer configuration art, and can result in valid orders becoming invalid quickly thus gaining efficiency and reducing administrative costs.

Art Unit: 3677

Re claims 23-25: Computer readable medium having stored thereon program instructions (inherent in electronic computer-based applications, and Oracle database is inherently computer readable) for implementing the method comprising:

- Allowing an incomplete order, for a configurable product, to be created wherein at least one item is not provided by user (page 2-3 – once the order is placed, you can get all your contract information online; page 5 – engineer begins order and then sends to purchasing for completion)
- Allowing further processing (done by purchasing)
- Receiving order in complete form with missing element(s) provided (pg 5)
- After complete order is received, determining if order processing information is still valid (pg 2)

However, Cisco is not explicit that incomplete orders are accepted and further processed. Mitra in para [0032] discusses processing incomplete orders where some information is missing, wherein further processing ((price verification) is done by seller 108,110 and the request is returned to buyer for completion. Revalidation was discussed in the paragraph above.

It would have been obvious to one of ordinary skill in the art, having the teachings of Cisco and Mitra before him at the time the invention was made, to modify Cisco to include processing orders without complete information, such as billing codes, as taught by Mitra, in order to ensure that orders are handled as rapidly and efficiently as possible, especially for known customers. One would have been motivated to make such a combination because fast processing time and order fulfillment is of vital

Art Unit: 3677

importance to customers, and meeting this need would ensure customer satisfaction and return.

11. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Inside the Cisco Web Site", hereafter called Cisco in view of Hensen USP 6167383.

Re claims 19-21: Cisco teaches a computer-implemented method and means for processing an electronically placed order for customer configured products with user registration on page 5, 3rd Q/A pair. However, Cisco is not specific on what registration/authentication data is used. Henson teaches in col 14 lines 4-61, that to order, customers can register, or can access the site unregistered, and that passwords (col 14 lines 35-38) can be used in certain situations but not all situations before allowing a customer to place an order. Company identification for user authentication is taught in col 14 lines 42-45.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Inside the Cisco Web Site", hereafter called Cisco in view of XML 1.0 WC3 Recommendation, hereafter called XML.

Re claim 18: Examiner notes that "**XML (Extensible Markup Language)** is a metalanguage approved as a World Wide Web Consortium (W3C) recommendation in February 1998, which is attached. A simplified version of Standard Generalized Markup Language (SGML), XML captures SGML's key advantages (such as extensibility) without its more obscure features. Because it is a metalanguage (a language to define languages), it intrinsically offers Hypertext Markup Language (HTML) capabilities and can be used to create HTML documents. A family of XML-related standards (formally

Art Unit: 3677

called "recommendations") has been under development by the W3C since 1997. These include XML Linking Language (XLink), XML Path Language (XPath), XML Pointer Language (XPointer), Extensible Stylesheet Language (XSL) and XSL Transformations (XSLT). Together, they form a critical foundation for today's Web-based computing and e-commerce infrastructures. (See **XLink**, **XPath**, **XPointer**, **XSL** and **XSLT**.)" (*Description from http://www4.gartner.com/6_help/glossary/GlossaryX.jsp, undated*)

The difference between the claims and Cisco is the claims recite XML compliance. It would have been obvious to one of ordinary skill in the art, having the teachings of Cisco and XML before him at the time the invention was made, to modify Cisco as taught by XML to include XML compliance, in order to obtain compatibility with accepted internet standards. One would have been motivated to make such a combination because maximum interoperability and standardization would have been obtained, as taught/suggested by XML.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3677

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwm
3/25/04


ROBERT J. SANDY
PRIMARY EXAMINER